EXHIBIT K

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:

Johnson et al.

Serial No. 08/288,577

Filed: **August 10, 1994**

Art Unit: **2761**

Examiner: **Edward R. Cosimano**

Attorney Docket No.: **95-185**

ELECTRONIC SOURCING SYSTEM AND METHOD

Pittsburgh, Pennsylvania 15230

Assistant Commissioner for Patents
 and Trademarks
Washington, D.C. 20231

RESPONSE TO SECOND OFFICE ACTION, DATED MAY 26, 1998

Dear Sir:

Responsive to the second Office Action dated May 26, 1998, please amend the above-captioned application as follows, permitting the allowed and allowable claims to issue immediately. Applicants reserve the right to pursue the rejected claims (and others) in a continuation application.

AMENDMENT

Applicants respectfully request entry of the following amendments in the above-captioned application:

IN THE SPECIFICATION:

On page 12, lines 32-33, please replace: "Application Serial No. 08/042,168" with: -- U.S. Patent No. 5,712,989 --.

IN THE CLAIMS:

Please cancel claims 88 and 89.

Please amend the following claims:

79. (Amended) An electronic sourcing system comprising:

at least two [vendor] product catalogs containing data relating to items associated with the respective [vendors] sources;

means for selecting the [vendor] product catalogs to search;

means for searching for matching items among the selected [vendor] product catalogs;

means for building a requisition using data relating to selected matching items and their associated [vendor(s)] source(s); [and]

means for processing the requisition to generate one or more purchase orders for the selected matching items[.];
and

means for determining whether a selected matching item is available in inventory.

80. (Amended) The electronic sourcing system of claim 79 wherein the purchase orders include data relating to a [vendor] catalog number for the selected matching items.

81. (Amended) An electronic sourcing system comprising:

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at least two [vendor] product catalogs containing data relating to items associated with the respective [vendors] sources;

means for selecting the [vendor] product catalogs to search;

means for searching for matching items among the selected [vendor] product catalogs;

means for building a requisition using data relating to selected matching items and their associated [vendor(s)] source(s); [and]

means for processing the requisition to generate one or more purchase orders for the selected matching items[.]; and

means for converting data relating to a selected matching item and an associated source to data relating to an item and a different source.

82. (Amended) The electronic sourcing system of claim [79] 81 further comprising means for determining whether a selected matching item is available in inventory.

83. (Amended) The electronic sourcing system of claim [79] 81 further comprising means for determining the applicable price of a selected matching item.

84. (Amended) An electronic sourcing system comprising:

a database containing data relating to items associated with at least two [vendors] sources;

means for searching for matching items in the database;

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means for building a requisition using data relating to selected matching items and their associated [vendors] sources; [and]

means for processing the requisition to generate one or more purchase orders for the selected matching items[.];
and

means for determining whether a selected matching item is available in inventory.

85. (Amended) An electronic sourcing system of claim [84] 87 wherein the requisition includes matching items from at least two [vendors] sources.

86. (Amended) The electronic sourcing system of claim [84] 87 wherein the purchase orders include data relating to [vendor] catalog numbers.

87. (Amended) An electronic sourcing system comprising:

a database containing data relating to items associated with at least two [vendors] sources;

means for searching for matching items in the database;

means for building a requisition using data relating to selected matching items and their associated [vendors] source(s);

means for processing the requisition to generate one or more purchase orders for the selected matching items[.];
and

means for converting data relating to a selected matching item and an associated source to data relating to an item and a different source.

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92. (Amended)   An electronic sourcing system comprising:

at least two [vendor] product catalogs containing data relating to items associated with the respective [vendors] <u>sources</u>;

means for searching for matching items among the [vendor] product catalogs;

means for building a requisition that includes a first matching item and a second matching item, each associated with a different [vendor] <u>source</u>; [and]

means for processing the requisition to generate purchase orders for the first and the second matching items[.]<u>;</u> <u>and</u>

<u>means for converting data relating to a selected</u> <u>matching item and an associated source to data relating to an</u> <u>item and a different source.</u>

95. (Amended)   An electronic sourcing system comprising:

data relating to items associated with at least two [vendors] <u>sources</u> maintained so that selected data may be searched separately;

means for searching for matching items among the selected data;

means for building a requisition using data relating to selected matching items and their associated [vendor(s)] <u>source(s)</u>; [and]

means for processing the requisition to generate purchase orders using data relating to the selected matching items and their associated [vendor(s).] <u>source(s); and</u>

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means for determining whether a selected matching item is available in inventory.

96. (Amended) The electronic sourcing system of claim [95] 98 wherein the purchase orders use data relating to at least two [vendors] sources.

97. (Amended) The electronic sourcing system of claim [95] 98 wherein the purchase orders use data relating to [vendor] catalog numbers.

98. (Amended) An electronic sourcing system comprising:

        data relating to items associated with at least two [vendors] sources maintained so that selected data may be searched separately;

        means for searching for matching items among the selected data;

        means for building a requisition using data relating to selected matching items and their associated [vendor(s)] source(s); [and]

        means for processing the requisition to generate purchase orders using data relating to the selected matching items and their associated [vendor(s).] source(s); and

        means for converting data relating to a selected matching item and an associated source to data relating to an item and a different source.

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99. (Amended)   The electronic sourcing system of claim [95] 98 further comprising means for determining whether a selected matching item is available in inventory.

100. (Amended)   The electronic sourcing system of claim [95] 98 further comprising means for determining the applicable price of a selected matching item.

103. (Amended)   The electronic sourcing system of claim 101 further comprising means for converting data relating to a selected matching item and [its] an associated [vendor] source to data relating to an item and a different [vendor] source [and a corresponding item].

104. (Amended)   An electronic sourcing system of claim 101 wherein the requisition includes matching items from at least two [vendors] sources.

105. (Amended)   The electronic sourcing system of claim 104 wherein the purchase orders include data relating to the [vendor] source associated with the selected matching item.

108. (Amended)   A method comprising the steps of:

maintaining at least two [vendor] product catalogs on a database containing data relating to items associated with the respective [vendors] sources;

selecting the [vendor] product catalogs to search;

searching for matching items among the selected [vendor] product catalogs;

building a requisition using data relating to selected matching items and their associated [vendor(s)] source(s); [and]

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processing the requisition to generate one or more purchase orders for the selected matching items[.]; and

determining whether a selected matching item is available in inventory.

28 110. (Amended)   A method comprising the steps of:

maintaining at least two [vendor] product catalogs on a database containing data relating to items associated with the respective [vendors] sources;

selecting the [vendor] product catalogs to search;

searching for matching items among the selected [vendor] product catalogs;

building a requisition using data relating to selected matching items and their associated [vendor(s)] source(s); [and]

processing the requisition to generate one or more purchase orders for the selected matching items[.]; and

converting data relating to a selected matching item and an associated source to data relating to an item and a different source.

29 111. (Amended)   The method of claim [108] 110 28 further comprising the step of determining whether a selected matching item is available in inventory.

30 112. (Amended)   The method of claim [108] 110 28 further comprising the step of determining the applicable price of a selected matching item.

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113. (Amended) A method comprising the steps of:

maintaining a database containing data relating to items associated with at least two [vendors] sources;

searching for matching items among the data relating to the items;

building a requisition using data relating to selected matching items and their associated [vendor(s)] source(s); [and]

processing the requisition to generate purchase orders using data relating to the selected matching items and their associated [vendor(s).] source(s); and

determining whether a selected matching item is available in inventory.

32/ 114. (Amended) The method of claim [113] 116 wherein the purchase orders use data relating to at least two [vendors] sources.

33 115. (Amended) The method of claim [113] 116 wherein the purchase orders use data relating to [vendor] catalog numbers.

31 116. (Amended) A method comprising the steps of:

maintaining a database containing data relating to items associated with at least two [vendors] sources;

searching for matching items among the data relating to the items;

building a requisition using data relating to selected matching items and their associated [vendor(s)] sources; [and]

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processing the requisition to generate purchase orders using data relating to the selected matching items and their associated [vendor(s).] source(s); and

converting data relating to a selected matching item and an associated source to data relating to an item and a different source.

34 ~~117.~~ (Amended)   The method of claim [113] ~~116~~ 31 further comprising the step of determining whether a selected matching item is available in inventory.

35 ~~118.~~ (Amended)   The method of claim [113] ~~116~~ 31 further comprising the step of determining the applicable price of a selected matching item.

119. (Amended)   A method comprising the steps of:

maintaining a database containing at least two [vendor] product catalogs containing data relating to items associated with the respective [vendors] sources;

searching for matching items among the [vendor] product catalogs;

building a requisition that includes a first matching item and a second matching item, each from a different [vendor] product catalog; [and]

processing the requisition to generate purchase orders for the first and the second matching items[.]; and

determining whether a selected matching item is available in inventory.

37 ~~120.~~ (Amended)   The method of claim [119] ~~121~~ 36 wherein a first purchase order uses data relating to the first matching

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item and a second purchase order uses data relating to the second
matching catalog item.

36 121. (Amended)   A method comprising the steps of:

maintaining a database containing at least two
[vendor] product catalogs containing data relating to items
associated with the respective [vendors] sources;

searching for matching items among the [vendor]
product catalogs;

building a requisition that includes a first
matching item and a second matching item, each from a different
[vendor] product catalog; [and]

processing the requisition to generate purchase
orders for the first and the second matching items[.]; and

converting data relating to a selected matching
item and an associated source to data relating to an item and a
different source.

38 122. (Amended)   The method of claim [119] 121 further
comprising the step of determining whether a selected matching
item is available in inventory.

39 123. (Amended)   The method of claim [119] 121 further
comprising the step of determining the applicable price of a
selected matching item.

40 124. (Amended)   A method comprising the steps of:

maintaining a database containing data relating to
items associated with at least two [vendors] sources whereby
selected portions of the database may be searched separately;

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searching for matching items among the selected portions of the database;

building a requisition using data relating to selected matching items and their associated [vendor(s)] source(s); [and]

processing the requisition to generate purchase orders using data relating to the selected matching items and their associated [vendor(s).] source(s); and

determining whether a selected matching item is available in inventory.

125. (Amended)   The method of claim [124] 126 wherein a first purchase order uses data relating to selected matching items from a first [vendor] source and a second purchase order uses data relating to selected matching items from a second [vendor] source.

126. (Amended)   A method comprising the steps of:

maintaining a database containing data relating to items associated with at least two [vendors] sources whereby selected portions of the database may be searched separately;

searching for matching items among the selected portions of the database;

building a requisition using data relating to selected matching items and their associated [vendor(s)] source(s); [and]

processing the requisition to generate purchase orders using data relating to the selected matching items and their associated [vendor(s).] source(s); and

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converting data relating to a selected matching item and an associated source to data relating to an item and a different source.

127. (Amended)   The method of claim [124] 126 further comprising the step of determining whether a selected matching item is available in inventory.

128. (Amended)   The method of claim [124] 126 further comprising the step of determining the applicable price of a selected matching item.

REMARKS

Claims 101-107 and 129 have been allowed.

Applicants have amended claims 81, 87, 98, 110, 116, 121 and 126 in independent form, per the Examiner's suggestion, and believe that these claims are now in condition for allowance. Applicants believe the claims dependent therefrom likewise are in condition for allowance, specifically: claims 82 and 83 (dependent from claim 81); claims 85, 86, 90 and 91 (dependent from claim 87); claims 96, 97, 99 and 100 (dependent from claim 98); claims 111 and 112 (dependent from claim 110); claims 114, 115, 117 and 118 (dependent from claim 116); claims 120, 122 and 123 (dependent from claim 121); and claims 125, 127 and 128 (dependent from claim 126). Applicants believe that claim 92 and those dependent therefrom (claims 93 and 94) are likewise in condition for allowance since they have been amended in accordance with the Examiner's suggestion as to the other claims.

Applicants have clarified the above claims by amending "vendor" to read "source". As Applicants explained in response to the first Office Action, the term "vendor" includes different suppliers and different sources from the same supplier, e.g.

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different warehouse locations. See Response to first Office Action at pages 11-12. Applicants believe that the use of the term "source" in place of "vendor" more distinctly claims what they regard as their invention.

Applicants also have clarified those claims that contain the "means for converting" element or the "converting" step. Those claims properly refer to converting the "data relating to an item and a different source". This was one of the elements that the Examiner determined was not taught or suggested by the prior art (see item 7 of second Office Action). Applicants believe that the new language more distinctly claims the invention where, for example, the identical selected matching item were to be ordered from a different source. The prior language, "corresponding item", could have been misunderstood. The amended language properly claims identical matching items from different sources, as well as a suitable replacement for the selected matching item.

As to independent claims 79, 84, 95, 108, 113, 119 and 124, Applicants respectfully traverse the Examiner's 102(b) rejection based on Dworkin. Nevertheless, without prejudice to Applicants arguing the rejection at a later time, Applicants have amended the claims to clearly overcome the prior art. Dworkin does not teach or suggest the ability to check availability of selected items. Applicants' system and method permits availability determination, enabling purchasers to make informed purchasing decisions, e.g., ordering from a source where the selected item is in inventory versus ordering from a source that would require a back order. As amended, Applicants believe these claims to be in condition for allowance.

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REMAINING ISSUES RAISED IN THE SECOND OFFICE ACTION:

       As to the trademark issues raised by the Examiner, Applicants have reviewed the application and believe that the trademarks have been used properly. Applicants would welcome any guidance from the Examiner if he does not agree.

       Applicants submit herewith proposed corrections to the drawings (shown in red). If the corrections are acceptable, Applicants will submit the corrections with the formal drawings.

       Applicant submit herewith replacement pages for Appendices I through X, with correct margins.
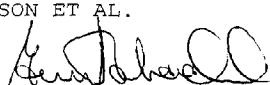
       Applicants believe that the above claims are in condition for allowance. Applicants would welcome the opportunity to interview this case in order to facilitate early issuance of the allowed claims. Applicants respectfully request the Examiner's prompt and favorable consideration.

Respectfully submitted,

JOHNSON ET AL.

Dated: September 14, 1998

By _____

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